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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/872,522	06/04/2001	Hideyuki Sakamoto	NEC01P072-TSe	3317

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EXAMINER

GARCIA, ERNESTO

ART UNIT PAPER NUMBER

3679

DATE MAILED: 12/31/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/872,522

Applicant(s)

SAKAMOTO, HIDEYUKI

Examiner

Ernesto Garcia

Art Unit

3679

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-59 is/are pending in the application.
- 4a) Of the above claim(s) 23-32 and 34-59 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-22 and 33 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 October 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

The disclosure is objected to because of the following informalities: applicant has failed to identify "the means for limiting further use of the trial purchase system".

Appropriate correction is required.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 5 and 6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Equinox's web page.

Regarding claim 1, the web page discloses a method of trial purchase, the method includes:

Art Unit: 3679

display information of a commodity (see serial hubs info), provided from a commodity providing means (the company, Equinox), on at least one terminal (computers connected to the internet); and,

an user (the buyer), using the terminal, performs a purchase procedure.

However, Equinox's web page fails to include an additional step:

limit further use of the purchase procedure by users who have had prior experience with the purchase procedure. Applicant is reminded that this step can be easily performed as the step relates to the user's desire to further use the company's commodities. For instance, the user can limit not to order another free trial of the commodity by the same company for reasons of dislike of the commodity; thus, the user, who has had prior experience with the purchase procedure, would limit further use of the purchase procedure.

Regarding claim 2, the method further includes:

previously store a destination of the commodity (the address is stored on the server before delivery of the product); and,

provide the commodity to the destination.

Regarding claims 5 and 6, the commodity (the serial hubs) is free of charge.

Claims 1-22 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Start Sampling.

Regarding claim 1, the startsampling.com's web page discloses a method of trial purchase, the method includes:

display information of a commodity (peanuts, tea, nasal strips, lifesavers are display on the first page) provided from a commodity providing means (the company or the site startsampling.com) on terminals (computers connected to the internet); and users (the buyers), using the terminals, perform a purchase procedure.

However, Start Sampling's web page fails to include an additional step:

limit further use of the purchase procedure by users who have had prior experience with the purchase procedure. Applicant is reminded that this step can be easily performed as the step relates to the user's desire to further use the company's commodity. For instance, the user can limit not to order another free trial of the commodity by the same company for reasons of dislike of company's service.

Therefore, the user, who has had prior experience with the purchase procedure, would limit further use of the purchase procedure for disliking the service.

Regarding claim 2, the method further includes:

previously store a destination of the commodity (an address is stored on the server when the user enrolls to get products); and, provide the commodity to the destination.

Regarding claim 3, the method further includes:

previously store a destination of the commodity (an address is stored on the server when the user enrolls to get products),

display the destination on the terminals when the commodity is specified on the terminals; and,

designate the destination or a newly designated destination as a destination of the commodity (users are allowed to change the address on the account).

Regarding claim 4, the method further includes:

storing the newly designated destination (a save button is usually associated with the account to update information).

Regarding claims 5-8, the commodity (samples are free of charge) is free of charge.

Regarding claims 9-22 and 33, given the method described by startsampling.com above, the trial purchase system is inherently constructed.

Regarding claim 9, Start Sampling's web page disclose a trial purchase system comprising terminals (computers connected through a network), a commodity providing means (a company), a network (the internet), and a means (a terminal's on or off switch) for limiting further use of the trial purchase system. The commodity providing means is connected to the terminals through the network.

Applicant is reminded that the commodity providing means is able to display information on a commodity (a product) for trial purchase on one of the terminals. The providing means can also provide the commodity for trial purchase to a destination designated on the terminal when the commodity for trial purchase is specified on the terminal.

Regarding claim 10, the commodity providing means includes means for previously storing the destination (a database in a company's computer) and providing the commodity to the destination (a shipping department) when the commodity is specified on the terminal.

Regarding claim 11, the commodity providing means includes means for previously storing the destination and providing the commodity to a new designated destination when the commodity is specified on the terminal and the new destination is designated therefor.

Regarding claim 12, the commodity providing means includes means for storing the new designated destination (the company's database).

Art Unit: 3679

Regarding claims 13-15, the system further includes customer information storing means (hard drive on the company's computer) for storing information on the destinations.

Regarding claims 16-22, the system further comprises commodity information storing means (product database). Applicant is reminded that the commodity information storing means is for storing information on the commodity.

Regarding claim 33, the commodity providing means includes means (the shipping department) for providing said commodity for trial purchase at no charge.

Response to Arguments

Applicant's arguments filed 10/22/03 have been fully considered but they are not persuasive.

Applicant has argued that the Equinox web site does not provide for a delivery commitment, but rather simply information to be used by an Equinox representative in a call back to the potential customer. This argument is irrespective as the claim does not disclose a step to "provide delivery commitment". Even if the statement were recited in the claim, Equinox provides delivery of the product despite the sales representative calling the customer before delivery. Equinox possibly calls the customer to verify the

Art Unit: 3679

information before committing to deliver the product. A company running this kind of service would probably verify the information to protect the product from not being returned to the company after the free trial.

Applicant has argued that the Equinox's web site has no indication that a customer who once uses the product evaluation page would be unable to use the page to evaluate another product on similar "no risk" terms. In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., limiting further use of said commodity providing means or limiting use of said commodity providing means to one time.) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Applicant has argued that participation, in Start Sampling's web page, is not provided to new users on a limited basis. Applicant is reminded that web pages do not provide participation but rather the user using the web page provides participation by either clicking or entering information into the web page. If applicant is concerned about the ability for a customer to participate in the web page on a limited basis, the web page is able to restrict participation as the amount of free samples available are reduced, i.e., if the amount of samples available is zero then there would not be participation at all by the customer as there are no free samples to get. Applicant has further elaborated that

Art Unit: 3679

free samples are provided on a first-come, first serve basis without any evident limitation on return visits by a customer. The examiner strongly believes that someone establishing an account with the site will most likely return to visit the page to get more free samples.

Applicant has argued that the Start Sampling's web page has no indication of any intention or purpose to overcome hesitancy of a customer who is new to the online purchase experience. This argument is diverging from what the applicant is claiming. The invention is directed toward a method of trial purchase and not a method of overcoming hesitancy of a customer new to online purchasing. Start Sampling's solves hesitance since a customer does not have to pay. If the site is given to someone who has not heard of the service, that someone will most likely not hesitate to get free samples.

Conclusion

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Nature's Web Site (information) shows a similar method of free trial purchase with limited access to the commodity. The FreeSite.com shows a similar method of free trial purchase with limited to one commodity per household, which requires a limited purchase procedure.

Art Unit: 3679

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ernesto Garcia whose telephone number is 703-308-8606. The examiner can normally be reached from 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Lynne H Browne can be reached on 703-308-1159. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications. Any inquiry of a general nature or relating to the status of this

Art Unit: 3679

application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.



Lynne H. Browne
Supervisory Patent Examiner
Technology Center 3600

E.G.

December 22, 2003